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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,039	07/24/2000	David Crawford Gibbon	109579-Cont	6617

7590
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10/25/2002

EXAMINER

CHEN, TE Y

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 10/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/625,039

Applicant(s)
Gibbon et al.

Examiner
Te Chen

Art Unit
2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 22, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-56 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5-6 6) ☐ Other:

Art Unit: 2171

DETAILED ACTION

1. Claims 28-56 are presented for examination.
2. It is noted that although the present application does contain line numbers in the specification and claims, the line in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both Examiner and Applicant all future correspondence should include the recommended line numbering.

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation are requested in correcting any errors of which applicants may become aware in the specification.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 2783

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 28, 36 and 37, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 28 of U.S. Patent No. 6,098,082. Although the conflicting claims are not identical, they are not patentably distinct from each other because these two systems claim substantially the same subject matters, comprising: a method for automatically providing a compressed rendition of video program in a format suitable for electronic searching and retrieval. Wherein, the method having the steps of : a) receiving the condensed version of a video program with image and at least one of associated audio or text in form of frame for each segment of the video component; b) automatically transforming the electronic data representation into a hypertext format, to form a hypertext pictorial transcript; and c) recording the hypertext pictorial transcript in an electronic medium,.

5. Although the '082 patent did not specifically claim that the hypertext pictorial transcript is retrievable by a hand held (or wireless) device; however, using a hand held (or wireless) device to retrieve hypertext document is well known and widely used in the art of multi media Internet

Art Unit: 2783

processing, for reference please see, Dom et al. (U.S. Patent No. 6,166,735; Abstract; col. 7, lines 62-65].

6. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine this well known hand held (or wireless) device in his invention, thereby providing a broader scope of multi-media communication service.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2783

8. Claims 28-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Dom et al. (U.S. Patent No. 6,166,735).

9. As to claims 28, 36, and 37, Dom et al. (Hereinafter referred as Dom) disclosed the invention as claimed, comprising a method having the following steps:

a) receiving the condensed version of a video program with image and at least one of associated audio or text in form of frame for each segment of the video component [20, 22; Fig. 2; col. 5, line 66 - col. 6, line 12; col. 12, lines 38-43; col. 13, lines 16-20];

b) automatically transforming the electronic data representation into a hypertext format, to form a hypertext pictorial transcript [col. 3, lines 15-37]; and

c) recording the hypertext pictorial transcript in an electronic medium [col. 10, lines 3-24; col. 12, lines 54-56], wherein the electronic medium is either a hand held or wireless device [col. 7, lines 62-65].

10. As to claims 29 and 31, Dom further disclosed that the video program is compressed for display on a computer [col. 9, lines 24-28]; and the hypertext pictorial transcript is retrievable by a set-top box [Fig. 3].

Art Unit: 2783

11. As to claims 30 and 32, Dom further disclosed that the video program is a full-broadcast television quality signal [col. 2, lines 28-30; col. 7, lines 62-65] and the hypertext pictorial transcript is retrievable by a set-top box [Fig. 3].

12. As to claims 33-35, 38-44, 47-53 and 56, Dom further disclosed that the method supports both the wired and wireless Internet data communication lines and multi-media devices processing [col. 2, lines 25-29; col. 3, lines 8-10; col. 7, lines 22-31; Fig. 1].

13. As to claims 45-46 and 54-55, Dom further disclosed that the hypertext pictorial transcript and the video program is stored in the portable device and can be used to selectively retrieve the video program, wherein the video program is partially transmitted to the portable device in response to the retrieval commands from the portable device [col. 9, lines 25-53; Fig. 2, Fig. 3].

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gibbon et al. (U.S. Patent No. 5,874,986) which disclosed a method for communicating audiovisual programs over a communication network.

Art Unit: 2783

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436. The fax phone numbers for this group are:

(703) 746-7238 (After Final Communication);

(703) 746-7239 (Official Communications); and

(703) 746-7240 (For Status Inquiries, Draft Communication).

17. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

Oct 09, 2002


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100